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EXAMINER

GETANEH, MESFIN S

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/647,208	<b>Applicant(s)</b> WATANABE ET AL.	
	<b>Examiner</b> MESFIN GETANEH	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to communications: RCE filed August 18, 2008 to the original filed August 26, 2003.
2. Claims 1-17 are pending in this application.

#### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 18, 2008 has been entered.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (Pub US 20020170973) in view of Doi (US Pat 5,995,712).**

**With regards to claim 1**, Teraura discloses an image forming system (copy machine with a facsimile function in FIG. 2) comprising:

a first image forming member (printing paper 13 of FIG. 1) having a data storage unit (RFID tag 14 in the printing paper 13 of FIG. 1); and

an image forming apparatus for forming an image on at least the first image forming member (copy machine of FIG. 2), wherein:

the image forming apparatus includes:

Teraura teaches a scanner 6 of FIG. 2 reads an image on the sheet of the document paper ([0068]-[0069]), and printing unit 11 in FIG. 5 prints image on a printing paper with RFID tag ([0081]).

However, Teraura does not explicitly teach an image reading unit for reading **a plurality of** images, which are printed on originals, respectively, to form image data each indicating the read images;

**a merging unit for merging the plurality of images into a single combined image;**

an image forming unit for forming the **combined image** on the single first image forming member; and

Doi teaches a copy function controller that has a combine copy function in which plural documents read by the image reading device are combined and formed on one recording sheet (col. 1, line 47-50 and col. 3, line 2-11).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine plural images into one for intermitting of the combine copy function is decreased and an efficiency of making a copy is enhanced (col.1, line 55-57).

Teraura teaches a data writing unit for writing **combined image** formed on the single first image forming member into the first image forming member (a third reader-

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writer 17 is provided to record data (RFID data), [0071], received data may include the RFID data to be written in the RFID tag 14, [0082]); and

the data storage unit stores the written image data ([0082]).

**With regards to claim 2**, which further limits claim 1, Teraura teaches further comprising:

a second image forming member (sheet of document printing paper 13); and a third image forming member (at least a sheet of second printing paper without RFID tag, [0017]), wherein:

the first image forming member further includes a data supply unit for supplying the stored image data to an external (first printing paper with RFID tag [0017]);

the image forming apparatus further includes a data reading unit for reading the image data supplied from the data supply unit (RFID data reading means for reading first RFID data, [0021]); and

the image forming unit utilizes the image data read by the data reading unit to form the image corresponding to the image data on one of the third image forming member and the second image forming member (printing unit 11 in FIG. 5 [0092]).

**With regards to claim 3**, Teraura teaches an image forming apparatus (copy machine with a facsimile function in FIG. 2) comprising:

Teraura teaches a scanner 6 of FIG. 2 reads an image on the sheet of the document paper ([0068]-[0069]), and printing unit 11 in FIG. 5 prints image on a printing paper with RFID tag ([0081]).

However, Teraura does not explicitly teach an image reading unit for reading **a plurality of** images, which are printed on originals, respectively, to form image data each indicating the read images;

**a merging unit for merging the plurality of images into a single combined image;**

an image forming unit for forming the **combined image** on a single first image forming member; and

Doi teaches a copy function controller that has a combine copy function in which plural documents read by the image reading device are combined and formed on one recording sheet (col. 1, line 47-50 and col. 3, line 2-11).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine plural images into one for intermitting of the combine copy function is decreased and an efficiency of making a copy is enhanced (col.1, line 55-57).

Teraura teaches a data writing unit for writing **combined image** formed on the single first image forming member into the first image forming member (a third reader-writer 17 is provided to record data (RFID data), [0071], received data may include the RFID data to be written in the RFID tag 14, [0082]).

**With regards to claim 4**, which further limits claim 3, Teraura teaches comprising:

a data reading unit for reading the image data from the first image forming member (RFID data reading means [0021]), wherein:

the image forming unit utilizes the image data read by the data reading unit to form the image corresponding to the image data on one of a third image forming member and a second image forming member (printing unit 11 as described in [0086] and [0088]).

**With regards to claim 5**, which further limits claim 4, Teraura teaches comprising: a display unit for displaying at least one image using the image data read by the data reading unit (liquid crystal display (LCD) unit 35 in FIG. 5).

**With regards to claim 6**, which further limits claim 4, Teraura teaches wherein the image data read by the data reading unit is plural pieces of image data (characters, figures, and photo images are plural piece of image data that can be read by the data reading unit [0111]), the image forming apparatus further comprising:

a selecting unit for receiving an operation to select at least one of the plural pieces of image data (the control circuit 29 in FIG. 5), wherein:

the image forming unit forms the image corresponding to the selected image data on the one of the single first image forming member and a single second image forming member (printing unit 11 as described in [0086] and [0088]).

**With regards to claim 7**, Teraura teaches an image forming apparatus (copy machine with a facsimile function in FIG. 2) comprising:

Teraura teaches a scanner 6 of FIG. 2 reads an image on the sheet of the document paper ([0068]-[0069]), and printing unit 11 in FIG. 5 prints image on a printing paper with RFID tag ([0081]).

However, Teraura does not explicitly teach an image reading unit for reading a **plurality of** images, which are printed on originals, respectively, to form image data each indicating the read images;

**a merging unit for merging the plurality of images into a single combined image;**

an image forming unit for forming the **combined image** on a single first image forming member; and

Doi teaches a copy function controller that has a combine copy function in which plural documents read by the image reading device are combined and formed on one recording sheet (col. 1, line 47-50 and col. 3, line 2-11).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine plural images into one for intermitting of the combine copy function is decreased and an efficiency of making a copy is enhanced (col.1, line 55-57).

Teraura teaches a data writing unit for writing layout data indicating positions where **combined image** on a single first image forming member **is** displayed into the first image forming member ((RFID data), [0071], received data may include the RFID data to be written in the RFID tag 14, [0082] and the copy machine in FIG. 2 and data writing unit of claim 1 also is capability of recording all the data from original paper to printing paper within a specified position. For example, if the original has A3 size paper and the user wants to print it in A4 size paper, the data writing has the inherent capability of having all the data from the A3 size paper fit in to the A4 size paper [0083]).



**With regards to claim 8**, which further limits claim 7, Teraura teaches comprising:

a data reading unit for reading the layout data from the first image forming member (RFID data reading means [0027] reads the image data which can include layout data), wherein:

the image reading unit reads the images formed on the first image forming member (a scanner 6 of FIG. 2 reads an image on the sheet of the document paper ([0068]-[0069])); and

the image forming unit divides the images read from the first image forming member in accordance with the read layout data and forms the divided images on one of a third image forming member and a second image forming member (The control circuit 29 is capable of controlling the printing unit 11 to print an image based on the command from PC 39, which can include a program instructions that can divide the image in accordance with a given read data [0081]).

**With regards to claim 9**, Teraura teaches an image forming apparatus (copy machine with a facsimile function in FIG. 2) comprising:

Teraura teaches a scanner 6 of FIG. 2 reads an image on the sheet of the document paper ([0068]-[0069]), and printing unit 11 in FIG. 5 prints image on a printing paper with RFID tag ([0081]).

However, Teraura does not explicitly teach an image reading unit for reading **plurality of** images, which are printed on originals, respectively, to form image data each indicating the read images;

**a merging unit for merging the plurality of images into a single combined image;**

an image forming unit for forming the **combined image** on a single first image forming member; and

Doi teaches a copy function controller that has a combine copy function in which plural documents read by the image reading device are combined and formed on one recording sheet (col. 1, line 47-50 and col. 3, line 2-11).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine plural images into one for intermitting of the combine copy function is decreased and an efficiency of making a copy is enhanced (col.1, line 55-57).

Teraura teaches a data writing unit for writing total number data indicating total number of the **plurality of images in the combined** formed on the single first image forming member into the first image forming member ((a third reader-writer 17 is provided to record data (RFID data), [0071], received data may include the RFID data to be written in the RFID tag 14, [0082] and the copy machine in FIG. 2 is capable of writing total number of images formed on printing paper).

**With regards to claim 10**, which further limits claim 9, Teraura teaches comprising:

a data reading unit for reading the total number data from the first image forming member (RFID data reading means for reading first RFID data, [0021]), wherein:

the image reading unit reads the images formed on the first image forming member (a scanner 6 of FIG. 2 reads an image on the sheet of the document paper ([0068]-[0069])); and

the image forming unit divides the images read from the first image forming member in accordance with the read total number data and forms the divided images on one of another first image forming member and a single second image forming member (The type of data whether the layout data or total number data can be provided by PC 39 in FIG. 5. And the control circuit 29 in FIG. 5 controls the printing unit 11 to print an image in accordance with the data provided. The control circuit 29 has the capability of dividing the images).

**With regards to claim 11**, Teraura teaches an image forming apparatus (copy machine with a facsimile function in FIG. 2) comprising:

Teraura teaches a scanner 6 of FIG. 2 reads an image on the sheet of the document paper ([0068]-[0069]), and printing unit 11 in FIG. 5 prints image on a printing paper with RFID tag ([0081]).

However, Teraura does not explicitly teach an image reading unit for reading **a plurality of** images, which are printed on originals, respectively, to form image data each indicating the read images;

**a merging unit for merging the plurality of images into a single combined image;**

an image forming unit for forming the **combined image** on a single first image forming member; and

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Doi teaches a copy function controller that has a combine copy function in which plural documents read by the image reading device are combined and formed on one recording sheet (col. 1, line 47-50 and col. 3, line 2-11).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine plural images into one for intermitting of the combine copy function is decreased and an efficiency of making a copy is enhanced (col.1, line 55-57).

Teraura teaches a data writing unit for writing size data, indicating sizes of the originals whose images are formed **in the combined image** on the single first image forming member into the first image forming member (a second reader-writer 16 and a third reader-writer 17 are provided to record the data (RFID data) in the RFID tag **[0071]**. And the data (RFID data) can be any data including an original size data from the original paper).

**With regards to claim 12**, which further limits claim 11, Teraura teaches comprising:

a data reading unit for reading the size data from the first image forming member (same as claim 4 data reading unit); and

a forming member selection unit for selecting an image forming member having size corresponding to the read size data (control circuit 29 in FIG. 5 **[0083]**), wherein:

the image reading unit reads the images formed on the first image forming member (same as claim 8 image reading unit); and

the image forming unit forms at least part of the read images on the selected image forming member (a third reader-writer 17 is provided to record data (RFID data), [0071], received data may include the RFID data to be written in the RFID tag 14, [0082]).

**With regards to claim 13**, Teraura discloses an image forming apparatus (copy machine with a facsimile function in FIG. 2) comprising:

Teraura teaches a scanner 6 of FIG. 2 reads an image on the sheet of the document paper ([0068]-[0069]), and printing unit 11 in FIG. 5 prints image on a printing paper with RFID tag ([0081]).

However, Teraura does not explicitly teach an image reading unit for reading **a plurality of** images, which are printed on originals, respectively, to form image data each indicating the read images;

**a merging unit for merging the plurality of images into a single combined image;**

an image forming unit for changing sizes of the read images in **the combined image by** a predetermined magnification to form the **a changed combined** image on a first image forming member; and

Doi teaches a copy function controller that has a combine copy function in which plural documents read by the image reading device are combined and formed on one recording sheet (col. 1, line 47-50 and col. 3, line 2-11, FIG. 7 shows reduction of multiple image scanned when they are combined into a single images).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine plural images into one for intermitting of the combine copy function is decreased and an efficiency of making a copy is enhanced (col.1, line 55-57).

a data writing unit for writing magnification data indicating the predetermined magnification into the first image forming member (a second reader-writer 16 and a third reader-writer 17 are provided to record the data (RFID data) in the RFID tag **[0071]**. And the data (RFID data) can be any data including magnification data).

**With regards to claim 14**, which further limits claim 13, Teraura teaches comprising:

a data reading unit for reading the magnification data from the first image forming member (a first reader-writer 15 is provided to read the data (RFID data) in the RFID tag **[0071]**. And the data (RFID data) can be any data including magnification data) wherein:

the image reading unit reads the images formed on the first image forming member (a scanner 6 of FIG. 2 reads an image on the sheet of the document paper ([0068]-[0069]); and

However, Teraura does not explicitly teach the image forming unit changes the images read from the first image forming member in accordance with the read magnification data to form changed images on one of another first image forming member and a single second image forming member.

Doi teaches a copy function controller that has a combine copy function in which plural documents read by the image reading device are combined and formed on one recording sheet (col. 1, line 47-50 and col. 3, line 2-11, FIG. 7 shows reduction of multiple image scanned when they are combined into a single images).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine plural images into one for intermitting of the combine copy function is decreased and an efficiency of making a copy is enhanced (col.1, line 55-57).

**With regards to claim 15**, Teraura discloses an image forming member (printing paper 13 of FIG. 1) on which at least one image displayed on at least one original is to be formed, comprising:

a data storage unit for receiving and storing image data of the at least one image displayed on the at least one original (RFID tag 14 in the printing paper 13 of FIG. 1);  
and

a data supply unit for supplying the stored image data to an external (The sheet of printing paper 13 has an RFID tag 14 has a data supply unit. See abstract).

**With regards to claim 16**, Teraura discloses an image forming method (copy machine with a facsimile function in FIG. 2) comprising:

Teraura teaches a scanner 6 of FIG. 2 reads an image on the sheet of the document paper ([0068]-[0069]), and printing unit 11 in FIG. 5 prints image on a printing paper with RFID tag ([0081]).

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However, Teraura does not explicitly teach reading **a plurality of** images, which are printed on originals, respectively, to form image data each indicating the read images;

However, Teraura does not explicitly teach **combining the read images into a combined image;**

forming the **combined image** on the single first image forming member; and

Doi teaches a copy function controller that has a combine copy function in which plural documents read by the image reading device are combined and formed on one recording sheet (col. 1, line 47-50 and col. 3, line 2-11).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine plural images into one for intermitting of the combine copy function is decreased and an efficiency of making a copy is enhanced (col.1, line 55-57).

Teraura teaches writing the image data indicating the **read images in the combined image** formed on the single first image forming member into the first image forming member (RFID data), [0071], received data may include the RFID data to be written in the RFID tag 14, [0082]); and

**With regards to claim 17**, a computer-readable medium storing a program causing a computer to perform an image forming process, the process comprising:

reading **a plurality of** images, which are printed on originals, respectively, to form image data each indicating the read images;

**combining the read images into a combined image;**



forming the **combined image** on the single first image forming member; and  
writing the image data indicating the **read images in the combined image**  
formed on the single first image forming member into the first image forming member  
(an image forming apparatus has a cpu and a storage medium that performs the  
operation the steps of claim 16 using the apparatus of claim 1).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MESFIN GETANEH whose telephone number is (571)270-3752. The examiner can normally be reached on 9:00AM-6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman can be reached on (571) 272-7653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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